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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,429	09/28/2000	Werner Zobel	655.00931	8171

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EXAMINER	
FORD, JOHN K	
ART UNIT	PAPER NUMBER
3743	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/672,429	Applicant(s) Zobel et al.
	Examiner FORD	Art Unit 3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☑ Responsive to communication(s) filed on 1/14/03 + 10/1/02

2a)☐ This action is FINAL. 2b)☑ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☑ Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☑ Claim(s) 9 is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☑ Claim(s) 5 is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☑ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .
18)☑ Interview Summary (PTO-413) Paper No(s). 9 .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other:

Applicant's response of Oct 1, 2002 (Paper No. 5) has been studied carefully. Applicant's cooperation in providing a translation of DE 197 24 728 is appreciated. It has allowed the Examiner to do more than a superficial consideration of what was undoubtedly the most important reference of record in this application up to the present time. The Examiner has also received a copy of the EP 1045217 A1 (the publication maturing from application 99107601.9) referenced on page 2, lines 5-6 of the specification. It has a publication date of October 18, 2000, after the US application date and foreign priority date of this application; hence it is not prior art here. If the Examiner's understanding in regard to the prior art status of EP'217 (or its underlying disclosure) is in error, Applicant is required to state for the record that it is to be considered as prior art and provide a brief explanation of why, otherwise it will be ignored.

Of more concern to the Examiner is the fact that the newly submitted translation of DE 19724728 discloses the existence of DE 29504867,which applicant did not provide a copy of, but obviously should have. A copy of the latter publication is enclosed here.

The Examiner also notes that DE '867 appears to disclose what counsel vigorously disputes applicants do/did not know about the largeness of the heat exchanger on pages 3 and 4 of Paper No. 5. It is also noted that DE 29504867 was

assigned to "Liebherr-Werk Bischofshofen Ges.m.b.H.", the same assignee as is found on USP 5,188,193 (also enclosed). While USP '193 does not disclose the details of the cooling system shown in DE'867 or DE'728 it does appear that Modine's predecessors were seeking patent protection in the United States, leading the Examiner to believe, absent proof to the contrary, that there was at least an intent to sell the heavy equipment shown there in the U.S.

Finally, counsel's analysis of why DE '728 is not prior art to this application under 35 U.S.C. 102 (b) is completely foreign to the Examiner's understanding of patent law. Is there some authority counsel is relying upon, or is this simply his own analysis?

The earliest date under 35 U.S.C. 119 that applicant is entitled to is October 21, 1999. DE 19724728, as correctly understood by counsel, was published February 25, 1999 and had an inventive entity different from the present one. Thus, it is the work of "others" and not the present inventive entity (in spite of the overlap in inventors). See In re Land, 151 USPQ 621 (CCPA 1966). More importantly however, the one year bar date under 35 U.S.C. 102 (b) is measured from the U.S. filing date, thus anything published before September 28, 1999 (by anyone, including the current applicants) is prior art under 35 U.S.C. 102 (b). See MPEP 2133. DE '728 is submitted to clearly be prior art under 35 U.S.C. 102 (b), counsel's theory of "effective filing date" notwithstanding. Again, if counsel has some treatise or scholarly work he is relying on to make this unorthodox argument about "effective filing date" in the context of 119

priority defeating a 102(b) bar, the Examiner would be very interested in knowing the author and obtaining a copy of the article.

It is also of great concern that applicants have not disclosed in any communication thus far the existence of WO 98/45600 corresponding to USP 6,164,909 which shows a radial fan (currently being claimed) and discloses that one of the inventor's named here (Mr. Ehlers) disclosed in 1998, with the publication of WO 98/45600, that the "length dimensions of the coolers (23,24,25) are not all the same. For example, the length dimension of the cooler (23) is shorter than the length dimension of both the coolers (25) and (26)" (also currently claimed). See USP 6,164,909 col. 3, lines 17-20 and corresponding disclosure (in German) in WO 98/45600.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,4,6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Ehlers et al. (USP 6,164,909 or WO 98/45600) and either of DE 19724728 or DE 29504867.

Ehlers et al. (USP'909 or WO'600) disclose a radial fan surrounded by at least three heat exchangers in a box-like structure.

The heat exchangers in Ehlers are different sizes with: "length dimensions of the coolers (23,24,25) are not all the same. For example, the length dimension of the cooler (23) is shorter than the length dimension of both the coolers (25) and (26)." See USP 6,164,909 col. 3, lines 17-20 and corresponding disclosure (in German) in WO 98/45600.

Both DE'728 and DE'867 teach different length heat exchangers oriented in offset relation as claimed. To have projected the different length cores 23, 25 and 26 of Ehlers ef al. to project forwardly and/or rearwardly of one another would have been obvious in view of the respective teachings of DE'728 (Fig 1) and DE '867 (Figs 1-7).

Claims 1,4,6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1,4,6 and 7 above, and further in view of DT 2716997 or Fachbach (USP 3,978,919).

Each of these references explicitly teaches journaling the fan to the rear panel of a heat exchange system analogous to that disclosed in the prior art discussed above. To the extent that Ehlers et al. (USP'909 or WO'600) lacks explicit disclosure of journaling it is submitted that it must exist to permit V-belt 28 to be tensioned. Only out

of an abundance of caution does the examiner rely on DT'997 or Fachbach to explicitly teach what is inherently disclosed in Ehlers et al., namely journaling to the rear wall of the fan box an advantageous location in not blocking air flow.

Claim 2,3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the prior art as applied to claims 1,4,6 and 7 above, and further in view of Beasley et al. (USP 4,730,669)

Beasley in Figure 12 shows a charge air cooler core (col. 5, line 66 – col. 6, line 3) with a core depth significantly greater than the cooling radiator shown in Figure 1. Charge air coolers cooled by air are known to be relatively large as evidenced by Emmerling (USP 4,317,439) col. 1, lines 28-43. Emmerling forms no part of this rejection except to show what is deemed common knowledge in this art.

To have used the relatively thick charge air cooler core disclosed in Beasley Figure 12 in place of the top mounted (horizontal) charge air core of the prior art discussed above for the purpose of improved cooling of the charge air would have been obvious to one of ordinary skill in the art.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,4,6 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 or claims 1-18 of U.S. Patent No. 6,564,857 or 6,164,909, respectively in view of either DE 19724728 or DE 29504867.

Both DE'728 and DE'867 teach different length heat exchangers oriented in offset relation as claimed. To have projected the different cores claimed in USP'857 or USP'909 to project forwardly and/or reawardly of one another would have been obvious in view of the respective teachings of DE '728 (Fig 1) and DE '867 (Figs 1-7).

Claim 2,3 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 or claims 1-18 of U.S. Patent No. 6,564,857 or 6,164,909, respectively in view of DE'728 or DE'867 and Beasley.

The rejection of claims 1,4,6 and 7 is explained above. Beasley in Figure 12 shows a charge air cooler core (col. 5, line 66 – col. 6, line 3) with a core depth

significantly greater than the cooling radiator shown in Figure 1. Charge air coolers cooled by air are known to be relatively large as evidenced by Emmerling (USP 4,317,439) col. 1, lines 28-43. Emmerling forms no part of this rejection except to show what is deemed common knowledge in this art.

To have used the relatively thick charge air cooler core disclosed in Beasley Figure 12 in place of the top mounted (horizontal) charge air core of USP 6,564,857 discussed above for the purpose of improved cooling of the charge air would have been obvious to one of ordinary skill in the art.

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to John Ford at telephone number 703-308-2636.

John K. Ford
Primary Examiner